

REMARKS

The Office Action mailed November 15, 2005, has been reviewed. Claims 1-15 remain in this application in which claims 1 and 8-14 have been amended. In view of the above referenced amendments, and the remarks recited herein, Applicants respectfully submit that claims 1-15 are now in condition for allowance and respectfully request such claims be passed to issue.

Rejection of Claims 8-15 Under 35 U.S.C. § 112

In the Office Action mailed November 15, 2005, claims 8-15 were rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for an aqueous cleaning solution, does not reasonably provide enablement for any type of cleaning solution. Applicants respectfully submit that the rejection of claims 8-15 has been obviated in view of the amendments made to such claims. That is, claims 8-15 have been amended herein to recite the introduction of a paraffin dissolving solvent which is enabled on page 4, lines 3-4, of the specification.

In view thereof, Applicants respectfully request that the rejection of such claims under 35 U.S.C. § 112, first paragraph, be withdrawn.

Rejection of Claims 8-15 Under 35 U.S.C. § 112

In the Office Action mailed November 15, 2005, claims 1-15 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner states that claims 1 and 8 are indefinite because of steps (e) and (d),

respectively, because it is unclear where the paraffin containing aqueous cleaning solution is passed to after leaving the mold receiving chamber.

Applicants respectfully traverse the Examiner's rejection of claims 1 and 8 as being indefinite because claims 1 and 8 are written so as not to define the location to which the paraffin containing aqueous solution is passed. MPEP § 2173.04 states that breadth of a claim is not to be equated with indefiniteness. Applicants submit that the subject matter of claims 1 and 8 is clear. Broadly, claims 1 and 8 involve introducing a cleaning solution into a mold receiving chamber for the purpose of the cleaning solution removing paraffin from a tissue embedding mold, and passing the paraffin containing solution from mold receiving chamber. Applicants submit that their invention as defining claims 1 and 8 is not directed to what happens to the paraffin containing cleaning solution after it has passed from the mold receiving chamber. In view of the above, Applicants submit claims 1 and 8 are definite.

Additionally, the Examiner states that claim 1, steps (b) and (d), are indefinite because "the tissue processing mold" lacks positive antecedent basis. Applicants respectfully submit that this was an inadvertent oversight by Applicants' attorney. Claim 1 is presently amended wherein the language "tissue processing mold" has been amended to recite the language "tissue embedding mold." Applicants respectfully submit that positive antecedent basis is now present in claim 1, as amended.

The Examiner also states that claim 1 is indefinite because it is unclear what one consider as a "sufficient amount." Applicants respectfully disagree with the Examiner's rejection, however, claim 1 has been amended herein in an effort to expedite such claim to issuance. Claim 1 has been amended to remove the word "sufficient" from the claim.

As such, claim 1 now recites "... an amount to cover the tissue embedding mold." Support for this amendment can be found on page 4, lines 1-2, reciting "[O]ne or more molds 101 are placed in a mold receiving chamber 119 of the cleaning vessel 102 and covered with a cleaning solution."

Claims 1 and 8 are also indefinite because it is unclear what is meant by "substantially free." Applicants submit that the fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. MPEP § 2173.05(b). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification. MPEP § 2173.05(b). In *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1998), the court held that the limitation "which produces substantially equal E and H plane illumination patterns" was definite because one of ordinary skill in the art would know what was meant by "substantially equal." MPEP § 2173.05(b)(D). In view thereof, Applicants submit that one of ordinary skill in the art would know what is meant by "...until the tissue embedding mold is substantially free of paraffin," as presently recited in claim 1.

In view of the remarks set forth above, Applicants respectfully request that the rejection of claims 8-15 be withdrawn and such claims passed to issue.

Obligation Under 37 CFR 1.56

In the Office Action mailed November 15, 2005, it was stated that this application currently names joint inventors. Applicants were advised of the obligation under 37 C.F.R. 1.56 to point out the inventor and invention dates of each claim that was not commonly

owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. § 103 (c) and potential prior art under sections (e), (f) or (g) of 35 U.S.C. §102. The Examiner is advised that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made.

Rejection of Claims 1-4, and 8-12 Under 35 U.S.C. § 103(a)

In the Office Action mailed November 15, 2005, claims 1-4 and 8-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Reinhardt et al. (2004/0002163).

Applicants respectfully submit that the prior art reference of Reinhardt et al. does not teach, disclose, or even suggest Applicants' invention as recited in claims 1-4 and 8-12. Claims 1 and 8 (and claims depending therefrom) of the present application are directed to a method for removing paraffin from a tissue embedding mold. Reinhardt et al. teach an automated high volume slide staining system. As discussed in paragraphs 34 and 35 and FIGS. 3 and 3A, the Reinhardt et al. reference teaches a de-paraffinizing station 140 comprising a modular compartment and including one or a plurality of wash dispense nozzles 142 directed downward at an angle to specimen slides. That is, Reinhardt et al. teach a de-paraffinizing station for specimen slides, not a method for removing paraffin from a tissue embedding mold as recited in claims 1 and 8 of the present application.

Specifically, Reinhardt et al. teach a process for removing paraffin from a slide having a biological sample thereon so that the slide may be stained with a dye thereby allowing the biological sample to be cover slipped and examined underneath a microscope. During this process, a ribbon of a biological sample, such as tissue (embedded in paraffin), is taken from a tissue block and placed on a slide. The paraffin must be removed prior to

staining the biological sample. However, in removing the paraffin from the slide, it is imperative that the biological sample remain thereon for staining and subsequent examination underneath the microscope.

Claims 1 and 8 of the present application recite a method for removing paraffin from a tissue embedding mold that is used for creating a tissue block. That is, prior to utilizing the process taught by the Reinhardt et al. reference, a tissue block must be created wherein a tissue sample is embedded within paraffin using a tissue embedding mold. After a tissue block has been created and removed from the mold, any tissue and paraffin residue left within the mold must be cleaned prior to re-using the mold for forming subsequent tissue blocks to prevent contamination to the subsequent tissue blocks.

Clearly, the Reinhardt et al. reference does not provide the necessary teaching or incentive to one of ordinary skill in the art to make the necessary modifications to the Reinhardt et al. apparatus to permit one to remove paraffin from a tissue embedding mold, as recited in claims 1 and 8. Applicants' invention is directed to cleaning a tissue embedding mold. However, Applicants submit that if one were to use the method recited in claims 1 and 8 of the present invention to remove paraffin from a slide having a biological sample thereon as taught by the Reinhardt et al. reference, one would clearly destroy the intended function of the Reinhardt et al. reference. That is, modifying Reinhardt et al. to remove paraffin from a tissue embedding mold would not allow paraffin residue to be removed from a slide without the biological sample being removed from the slide as well. To satisfy the intended function of the Reinhardt et al. reference, the biological sample must remain on the slide for staining and examination underneath a microscope.

For the foregoing reasons, it is respectfully requested that the rejection of claims 1-4 and 8-14 under 35 U.S.C. § 103(a) be withdrawn and such claims passed to issue.

Prior Art Made of Record

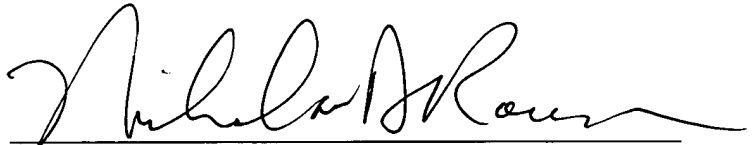
The prior art made of record and not relied upon has been reviewed. However, it is Applicants' belief that none of the references, either singularly or in combination, teach, disclose, or even suggest the apparatus claimed in the present application. Thus, no further comments concerning such references are deemed necessary.

CONCLUSION

This is intended to be a complete response to the Office Action mailed November 15, 2005. It is Applicants' belief that the inventive concept recited in the pending claims is patentable over the art of record and that such claims are necessary to afford Applicants with the degree of patent protection to which Applicants are entitled by law. In view of the above, Applicants respectfully submit the claims are in a condition for allowance and requests issuance of a Notice of Allowance thereof.

Should the Examiner have any questions or comments concerning the before-mentioned amendments to the application or any other matter, Applicants' attorney will welcome the opportunity to discuss same with the Examiner.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Nicholas D. Rouse", written over a horizontal line.

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